

**This Opinion is Not a
Precedent of the TTAB**

Mailed: October 5, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Almosafer Travel and Tourism Company

v.

Yamsafer Inc. dba Yamsafer

—
Cancellation No. 92063145
—

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for Almosafer Travel and Tourism Company.

Jonathan S. Batchelor of Dickinson Wright PLLC,
for Yamsafer Inc. dba Yamsafer.

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Before Taylor, Wellington, and Greenbaum,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Almosafer Travel and Tourism Company (“Petitioner”) has filed a petition to cancel Yamsafer Inc. dba Yamsafer’s (“Respondent”) registration on the Principal Register for the mark YAMSAFER (in standard characters) for “travel agency services, namely, making reservations and booking for temporary lodging” in

International Class 43.¹ The registration contains the following translation statement: “The English translation of ‘YAMSAFER’ is ‘YOU THE TRAVELLER.’”

In the Petition for Cancellation, Petitioner sets forth mere descriptiveness and genericness as the grounds for cancellation. Specifically, Petitioner asserts, *inter alia*, the following allegations:

- Petitioner has been “using the term ALMOSAFER for travel agency services ... since 2012”²;
- Respondent “asserted its federal registration for YAMSAFER against continued use of the [Petitioner’s] ALMOSAFER app in both Google Play and the Apple App Store”³;
- Respondent “claimed that the words ALMOSAFER and YAMSAFER have the same meaning, that is ‘traveler,’ that continued use by Petitioner of the ALMOSAFER app is causing confusion with the use of the YAMSAFER mark for travel agency services, and request[ed] that Google and Apple take down the ALMOSAFER app entirely from their respective app stores”⁴;
- “the word YAMSAFER means ‘traveler’” and “is generic for travel agency services, the services covered by [the involved Registration]”⁵;
- “YAMSAFER is merely descriptive for travel agency services, the services covered [by the involved Registration]”⁶; and
- Petitioner “has a valid and legal right to refer to its travel services by the merely descriptive or generic word “traveler” for travel agency services” and “is likely to be damaged by [the involved registration] because Respondent “is likely to prevent Petitioner from using its own ALMOSAFER name in commerce.”⁷

¹ Registration No. 4308644 issued on the Principal Register on March 26, 2013.

² 1 TTABVUE 3; Petition ¶ 1.

³ *Id.* at 4; ¶ 5.

⁴ *Id.*; ¶ 6.

⁵ *Id.*; ¶¶ 8 and 9.

⁶ *Id.*; ¶ 10.

⁷ *Id.*; ¶¶ 12 and 14.

In its answer, Respondent denies most of the salient allegations in the petition and raises several affirmative defenses.⁸ However, Respondent admits the following:

- “the word ALMOSAFER is a transliteration in English letters of an Arabic word for ‘traveler.’”⁹
- A member of [Respondent’s] staff sent notices to Apple and Google stating, “[Petitioner’s] app is infringing our [involved registration] rights and is in the same app store (travel) category. The meanings of ‘Almosafer’ and ‘Yamsafer’ are identical in Arabic and we have received numerous complaints by customers whom mistake the infringing app for the original one ...”¹⁰
- “ALMOSAFER and YAMSAFER are merely different transliterations in English letters of the same or nearly identical Arabic word.”¹¹

I. The Record

As far as evidence, the record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Registration No. 4308644.

The only evidence introduced are copies of Respondent’s discovery responses to Petitioner’s requests for admissions and interrogatories, submitted by Petitioner under a notice of reliance.¹² Of particular relevance, Respondent made the following admissions:

⁸ Respondent did not pursue any of the affirmative defenses at trial. The affirmative defenses are therefore deemed waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

⁹ 4 TTABVUE 2; Answer ¶ 4.

¹⁰ *Id.* at 2-3; ¶ 5 and repeated in ¶ 6.

¹¹ *Id.* at 3; ¶ 11.

¹² 11 TTABVUE (Petitioner’s notice of reliance). Petitioner also attempted to introduce other materials under this notice of reliance; however, the materials were stricken pursuant to a

- “Petitioner renders travel booking services.”¹³
- “[T]he term YAMSAFER is an anglicized version of an Arabic word that is closely approximated as ‘you the traveler’ when translated into English.”¹⁴

II. Standing

A threshold issue in every *inter partes* case is the plaintiff’s standing to challenge registration. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). With respect to cancellation proceedings, “[a] petitioner is authorized by statute to seek cancellation of a mark where it has ‘both a “real interest” in the proceedings as well as a “reasonable” basis for its belief of damage.’” *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062 (quoting *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) and citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999)).

Here, Petitioner’s interest in this proceeding is evidenced by key admissions made by Respondent in its Answer and in responses to Petitioner’s requests for admission. See *Estate of Ladislao Jose Biro v. Bic Corp.*, 18 USPQ2d 1382, 1383 & n.2 (TTAB 1991) (standing established by defendant’s admission in its answer). Specifically, as noted above, Respondent admitted that Petitioner “renders travel booking services.”¹⁵ Respondent also admitted in its Answer that it has referenced and relied upon the

Board interlocutory order granting Respondent’s motion to strike said materials. (See 16 TTABVUE – TTAB interlocutory order).

¹³ 11 TTABVUE 8 (response to admission Request No. 1).

¹⁴ *Id.* at 9 (response to admission Request No. 5).

¹⁵ See Note 13.

involved registration in notices sent to third parties, Apple and Google, with respect to travel software applications (“apps”) and stating Respondent’s belief that Petitioner’s app is “infringing” upon Respondent’s “rights.”¹⁶ These admissions demonstrate Petitioner has a relevant commercial interest in this matter as a direct competitor to Respondent, and standing to petition for cancellation. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Having determined that Petitioner has standing, we now address the substantive claims.

III. Petitioner’s Mere Descriptiveness Claim

A. Applicability of the Doctrine of Foreign Equivalents

“Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). In descriptiveness cases:

It is a well[-]established principle of trademark law in this country that the foreign equivalent of a merely descriptive English word is no more registrable than the English word itself despite the fact that the foreign term may not be commonly known to the general public. That is, normally no distinction can be made between English terms and their foreign equivalents with respect to registrability.

¹⁶ See Note 10.

In re Highlights for Children, Inc., 118 USPQ2d 1268 (TTAB 2016) (citing *In re Optica Int'l*, 196 USPQ 775, 777 (TTAB 1977) (finding OPTIQUE merely descriptive of eyeglass frames). “Foreign language words, not adopted into the English language, which are descriptive of a product, are so considered in registration proceedings despite the fact that the words may be meaningless to the public generally.” *Nestle’s Milk Prods., Inc. v. Baker Importing Co., Inc.*, 182 F.2d 193, 86 USPQ 80, 82 (CCPA 1950)).

The doctrine of foreign equivalent is applicable “when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. . . . The ‘ordinary American purchaser’ includes ‘all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1204 (TTAB 2017) (citations omitted). *See also In re Highlights for Children, Inc.*, 118 USPQ2d at 1271; *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006); 5 Callmann on Unfair Competition, Trademarks & Monopolies § 21:20 (4th ed. 2016) (“The doctrine of foreign equivalents applies when an ‘ordinary American purchaser’ would be likely to ‘stop and translate the foreign word into its English equivalent,’ and is generally applied to words from modern languages. . . .”) (footnotes omitted).

The aforementioned principles were recently reiterated by the Board in a proceeding with similar circumstances. *See In re S. Malhotra & Co. AG*, 2018 WL 4660940 (TTAB September 27, 2018). In *Malhotra*, the Board upheld the mere descriptiveness refusal to registration of the proposed marks: ΓΑΜΟΣ (the Greek

word for “wedding, matrimony or marriage”) and its transliteration, GÁMOS, both marks for jewelry and watches. The Board found that consumers would understand both terms as conveying information about an important feature of the goods, namely, they may be a type of jewelry worn for weddings.

In determining whether Arabic is a modern language, not so obscure that consumers would stop and translate, we rely on data released by the U.S. Census Bureau. According to this data, Arabic is one of the top ten commonly spoken languages in the United States after English and, as of 2017, there were over 924,000 people speaking Arabic at home, of whom over 550,000 also speak English “very well” or better.¹⁷ Based on this information, we find Arabic is a common, modern language spoken or understood by an appreciable number of U.S. consumers. Many of these bilingual consumers in the United States will stop, translate and understand the meaning of the transliteration YAMSAFER.

Having determined that the doctrine of foreign equivalents is applicable in this proceeding to the registered mark, YAMSAFER, a transliteration of an Arabic word, we now turn to the questions of (1) what is the meaning of the term and (2) whether the meaning is merely descriptive of Respondent’s services.

B. The Meaning of YAMSAFER and Whether It Is Merely Descriptive

¹⁷ “Detailed Languages Spoken at Home and Ability to Speak English for the Population 5 Years and Over for the United States: 2009-2013,” at <https://www.census.gov/data/tables/2013/demo/2009-2013-lang-tables.html>. Because the U.S. Census is a standard reference, we may, and do, take judicial notice of this information. *In re Olin Corp.*, 124 USPQ2d 1327, 1331 n.12 (TTAB 2017).

“Whether a mark is descriptive is a question of fact.” *Towers v. Advent Software Inc.*, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990). A term is considered descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), “if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012); *see also In re Bayer Aktiengesellschaft*, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re MBNA Am. Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

The Board has long held that a term is merely descriptive if it describes the intended user or consumer of the relevant services. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1456 (TTAB 2004) (with respect to the mark GASBUYERS for “providing online risk management services in the field of pricing and purchasing decisions for natural gas,” the Board held that “Applicant’s identification of services makes it clear that its services are directed to those who are in the field of making purchasing decisions for natural gas. The evidence supports the conclusion that these people would be referred to as gas buyers.”); *see also Hunter Publ’g Co. v. Caulfield Publ’g Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely descriptive of a trade journal directed toward users of large data processing systems; evidence sufficient to establish distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of retail mail-order services in the field of outdoor equipment and apparel).

In arguing that YAMSAFER is merely descriptive of the involved services, Petitioner asserts:¹⁸

In the present case, the relevant public consists of people seeking to make travel plans. The question is then, would those people understand a term denoting traveling to be a key aspect of a travel booking services? The answer is Yes. Respondent does not refute this; in fact, Respondent admits this.

Specifically, Petitioner asserts that “Respondent admits that the term YAMSAFER means ‘traveler’ in English,” referencing admissions made by Respondent in its answer.¹⁹ Petitioner acknowledges certain possible different connotations, but argues “whether the exact translation from Arabic to English is *hey traveler*, *you the traveler*, or *the traveler*, the primary meaning of the mark at issue is still traveler, which is generic for travel services” because “the variations in spelling are simply the variations in transliterating an Arabic word into English.”²⁰ According to Petitioner, the variations “should have little bearing on the overall meaning of the word and the significance to consumers.”²¹

¹⁸ 17 TTABVUE 15.

¹⁹ *Id.* Petitioner also relies on internet printouts from the “Google Translate” website (www.translate.google.com) that it attached to its brief. 17 TTABVUE 19-25. Respondent, in its brief, noted these materials were “never properly disclosed or admitted.” 18 TTABVUE 5. While the Board may take judicial notice of dictionary entries, including online dictionaries that exist in printed format or have regular fixed editions, there is no indication that the Google Translate website falls into any of these acceptable categories or otherwise constitutes an authoritative source of information. *Cf. Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). Accordingly, we have not considered these materials in our decision.

²⁰ *Id.* at 16.

²¹ *Id.*

Respondent, on the other hand, argues the term is “not generic or merely descriptive for travel booking services,” but is “suggestive.”²² Respondent contends that the term “merely approximates an anglicized version of an Arabic term that has a meaning similar to ‘you the traveler,’ [or ‘hey traveler’],” and that this meaning is neither generic nor merely descriptive for the services.²³

As far as the evidence of record concerning the meaning of YAMSAFER, there is very little. Indeed, neither party introduced a translation of the Arabic term from an authoritative resource. Nevertheless, there are Respondent’s aforementioned admissions made in response to allegations in the Petition for Cancellation and Petitioner’s discovery requests. Again, Respondent has admitted that YAMSAFER means “you the traveler”,²⁴ as well as two other admissions that, when read together, constitute an admission that the term is a transliteration of “the same or nearly identical Arabic word” that means “traveler.”²⁵ We further note that the involved registration contains a statement that the term means “You the traveler.”

The term “traveler” means “someone who is traveling or who often travels”²⁶ and is thus obviously merely descriptive of the intended consumer of Respondent’s travel agency services. Whether YAMSAFER means simply “traveler” or “you the traveler,”

²² 18 TTABVUE 5.

²³ *Id.*

²⁴ See Note 14.

²⁵ See Notes 9 and 11.

²⁶ We take judicial notice of the definition from *Webster’s New World College Dictionary* (4th ed. 2010).

we see little meaningful difference as to the overall meaning in the context of the involved services. That is, while there may be slight connotative differences, the same essential information with descriptive significance will be conveyed to the relevant consumer, namely that the involved services are for “travelers” or for “you the traveler.” As to the latter connotation in particular, there is no alternative meaning to the expression “you the traveler,” other than perhaps the perception that someone is speaking directly to you – in any event, a consumer viewing and understanding YAMSAFER will simply understand the meaning of the mark as, again, describing who is the target consumer of the travel agency services.

C. Conclusion

As Respondent correctly pointed out in its brief, Petitioner is the plaintiff in this *inter partes* proceeding and thus bears the burden of proving by a preponderance of the evidence the pleaded ground for cancellation. Under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), Respondent is entitled to prima facie presumptions that it is the owner of the valid, registered mark and has an right to exclusive use of the mark in commerce in connection with the identified services.

In this case, however, we find the preponderance of the evidence establishes that consumers of Respondent’s travel agency services who are knowledgeable of Arabic would immediately understand YAMSAFER to convey information about a feature of those services, namely, that travelers are the intended recipients of the services.

Because YAMSAFER immediately conveys knowledge about Respondent's services, it is merely descriptive under Trademark Act Section 2(e)(1).²⁷

Decision: The petition for cancellation is granted on the ground that Respondent's mark is merely descriptive of the services identified in the registration. The registration will be cancelled in due course.

²⁷ Respondent has not argued, let alone submitted evidence, that its mark has acquired distinctiveness; thus, we need not reach this issue. Moreover, because we find that Respondent's mark is merely descriptive and should be cancelled on this ground, we need not, and do not reach the genericness ground for cancellation.